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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/088,724 | 06/14/2002 | Ikuo Nishimoto | 082377-00000US | 6929 |

7590 05/04/2007
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| EXAMINER |
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CHERNYSHEV, OLGA N

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| ART UNIT | PAPER NUMBER |
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1649

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05/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/088,724 | Applicant(s) NISHIMOTO, IKUO | |
| | Examiner Olga N. Chernyshev | Art Unit 1649 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,13,20-22,27-30,35-38,43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,13,20,28 and 36 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 21- 22, 27,29, 30, 35, 37-38, 43 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1, 2, 4-8, 13, 20-22, 27-30, 35-38, 43 and 45 are pending and under examination in the instant office action.
2. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.
3. Applicant's arguments filed on April 11, 2007 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5, 6, 7, 8, 13, 20, 28 and 36 stand rejected under 35 U.S.C. 102(b) as being anticipated by Paznekas et al., 1997 (Biochem. Biophys. Res. Comm., 238, pp.1-6) and Dixon et al., 1997 (Hum. Mol. Gen., 6, No. 5, pp.727-37).

Applicant traverses the rejection on the premises that "a sequence as recited in the present claims (and including the generic sequence of SEQ D NO: 63 as explicitly defined in claim 1) is not disclosed by the cited references" (p. 7 of the Response). Applicant's argument has been fully considered but is not persuasive for the following reasons.

The instant rejection is based on the results of the sequence search provided by STIC, which revealed that a polypeptide with 100% identity to the instant polypeptide of SEQ ID NO: 63 was disclosed in two prior art references, publications of Paznekas et al. and Dixon et al. (see reasons of record in section 4 of Paper mailed on December 11, 2006). Applicant submits that the cited references do not disclose a polypeptide of SEQ ID NO: 63; however, there is no further identification as where within the text of the articles the similar sequences are presented and what the specific position limitations/differences between the sequences are. It is impossible for the Examiner to manually compare the sequences disclosed in the publications of record, therefore the Examiner relies on the results of the automated database sequence search, which shows the 100% hit between SEQ ID NO: 63 of the instant invention and sequences disclosed by Paznekas et al. and Dixon et al. articles. If it is Applicant's position that the sequence of SEQ ID NO: 63 with certain amino acid substitutions recited therein is different from the sequence disclosed by Paznekas et al. and Dixon et al., then Applicant is advised to submit that substituted sequence identified by a proper SEQ ID NO: so that a new search could be performed to align that sequence against the sequences of prior art.

Claim Objections

6. Claims 2, 4, 22, 27, 30, 35, 38, 43 and 45 stand objected to for reciting non-elected subject matter for reasons of record in section 5 of Paper mailed on December 11, 2006.

Conclusion

7. Claims 1, 5, 6, 7, 8, 13, 20, 28 and 36 are rejected. Claims 2, 4, 22, 27, 30, 35, 38, 43 and 45 are objected to. Claims 21, 29 and 37 are objected to for being dependent from rejected claims but would be allowed if rewritten in independent form.


8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Olga N. Chernyshev, Ph.D.
Primary Examiner
Art Unit 1649

May 1, 2007